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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,673	12/11/2001	Jhong Uhk Kim		4842
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SALVATORE C. MITRI			HENDERSON, MARK T	
263 Bryant Avenue			ART UNIT	PAPER NUMBER
Staten Island, NY 10306			3722	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/014,673	KIM, JHONG UHK
	Examiner	Art Unit
	Mark T Henderson	3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 March 2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 and 10-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 and 10-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: Attachment I, II, III.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 4, 5, 10, 13, 15 and 18 have been amended for further examination. Claim 9 has been canceled.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not understood what is meant by “dace” as stated in line 3. Should this be “face”?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- A person shall be entitled to a patent unless -
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1, 5-8, 10 and 15 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Whang (5,715,618).

Whang discloses in Fig. Fig. 1 and 4, a combined calendar and advertising format comprising: a plurality of printable stock (20), wherein each sheet has a top (28), a bottom, opposed sides, an upper face and a reverse face; a plurality of transversely defined panels on each

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sheet, wherein the first panel is the photograph, the second panel is the calendar year of 1997, and the third panel is the calendar year of 1998; a different monthly calendar contained on one of the panels of each sheet collectively spanning a calendar year; a means (holes (40) and binder (46)) to join the sheets (20) together at their tops (28).

4. Claims 1, 3, 5-7, 10, 12, 14, 15 and 17 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Pazicni (4,798,402).

Pazicni discloses in Fig. 1 and 3 and in Attachment IV, a combined and advertising format comprising: a plurality of printable stock (14), wherein each sheet has a top (14a), a bottom, opposed sides, an upper face and a reverse face; a plurality of transversely defined panels on each sheet, wherein the first panel is the priority spacing (30), the second panel is the calendar month of February, a different monthly calendar contained on one of the panels of each sheet collectively spanning a calendar year; a means (22) to join the sheets (14) together at their tops (14a); wherein the printed matter is commercial and personal advertising copies thereof and wherein the graphics can be pictorials (Col. 1, lines 11-15 and Col. 4, lines 39-42)

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-8, 10, 12-15, 17 and 18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bursaw (Des. 368,488).

Bursaw discloses in Fig. 1-3, a combined calendar and advertising format comprising: a sheet (A), wherein the sheet has an adjoining top (T), a bottom (B), opposed sides (S1 and S2), and upper face (F1, as seen in Fig. 3), and a reverse face (F2); a plurality of transversely defined panels (P1, P2, and P3) on the sheet; a plurality of commercial printed matter (Sports Illustrated Magazine), wherein graphics consist of photographs contained on each of the panels; a monthly calendar (the month of January) contained on one of the panels; and wherein a panel on each sheet contains a different monthly calendar, so that calendar spans a calendar year (1995 year).

However, Bursaw does not disclose: a plurality of panels on each sheet; wherein the printable stock is from about 20 lbs to 40 lbs; wherein the printed matter is in a form of commercial advertising identifying dining and eating establishments selected from the group consisting of catering halls, fast food chains, restaurants; wherein three transversely defined panels

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are contained on each sheet, wherein each sheet contains a different monthly calendar, printed matter and graphics.

In regards to **Claims 1, 10 and 15**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable number of sheets having panels, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include any number of sheets having any number of panels, since applicant has not disclosed the criticality of having any particular number, and invention would function equally as well any number of sheets and panels.

In regards to **Claims 4, 13, and 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desirable indicia on the sheets, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of calendar sheet does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there appears to be no new or unobvious structural relationship between the printed matter and the substrate which is required for patentability. Furthermore, a recitation of the intended use of the claimed invention

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must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the calendar/advertising format of Bursaw is capable of identifying dining and eating establishments depending on the indicia printed on the sheet.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many panels as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, the sheet of Bursaw is capable of having any number of panels depending on what indicia is to be disclosed on one sheet face.

6. Claims 2, 11 and 16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bursaw in view of Stanard (4,342,167).

Bursaw discloses a calendar/advertising format comprising all the elements as claimed in Claims 1, 10 and 15, and as set forth above. However, Bursaw does not disclose wherein the printable stock is from about 20-40 pound weight.

Stanard discloses in Col. 3, lines 40-43, a printable stock (1) having a weight of about 35 lbs.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bursaw's calendar/advertising format with a stock having a weight between 20-40 lbs, as taught by Stanard for the purpose providing a paper which receives printing ink well without bleeding or penetrating.

7. Claim 3, 12-14, 17 and 18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Whang.

Whang discloses a calendar and advertising format comprising all the elements as claimed in Claim 1, 10 and 15, and as set forth above. Whang further discloses wherein the graphics consist of artistic renderings or photographs. However, Whang does not disclose wherein the printed matter is commercial advertising copy and combination thereof; and wherein the printed matter is in a form of commercial advertising identifying dining and eating establishments selected from the group consisting of catering halls, fast food chains, restaurants.

In regards to **Claims 4, 13, and 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desirable indicia on the sheets, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of calendar sheet does

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not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there appears to be no new or unobvious structural relationship between the printed matter and the substrate which is required for patentability. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the printed matter of Whang is capable of being commercial and personal advertising copy and combinations thereof and capable of identifying dining and eating establishments depending on the indicia printed on the sheet.

8. Claims 4, 13 and 18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Pazicni.

Pazicni discloses a calendar and advertising format comprising all the elements as claimed in Claims 1, 10 and 15, and as set forth above. However, Pazicni does not disclose wherein the printed matter is in a form of commercial advertising identifying dining and eating establishments selected from the group consisting of catering halls, fast food chains, restaurants.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desirable indicia on the sheets, since it would only depend on the intended

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use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of calendar sheet does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there appears to be no new or unobvious structural relationship between the printed matter and the substrate which is required for patentability. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the printed matter of Pazicni is capable of being commercial and personal advertising copy and combinations thereof and capable of identifying dining and eating establishments depending on the indicia printed on the sheet.

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***Response to Arguments***

9. Applicant's arguments filed on March 22, 2004 have been fully considered but they are not persuasive.

In regards to applicant's argument that there is no teaching or suggestion "in the Bursaw patent of a calendar and advertising format having a plurality of transversely defined panels on each of the sheets containing printed matter and graphics on each panel and only (not stated in the claims) a monthly calendar on one of the panels, the examiner submits that Bursaw discloses in Fig. 1-3, a combined calendar and advertising format comprising: a sheet having a plurality of transversely defined panels (P1, P2, and P3); a plurality of commercial printed matter (Sports Illustrated Magazine), wherein graphics consist of photographs contained on each of the panels; a monthly calendar (the month of January) contained on one of the panels; and wherein a panel on each sheet contains a different monthly calendar, so that calendar spans a calendar year (1995 year). However, Bursaw does not disclose: a plurality of panels on each sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable number of sheets having panels, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include any number of sheets having any number of panels, since applicant has not disclosed the criticality of having any particular number, and invention would function equally as well any number of sheets and panels.

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*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

August 19, 2004



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